

PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mario Bogdan; David J. Lima; Keith J. Hocker; Tony J. Lillios
Serial No.: 09/940,261
Filed: August 27, 2001
Title: HELICAL DRIVE INSERTION AND EJECTION

Examiner: Rick Kiltae Chang
Group Art Unit: 3729
Docket No.: 1014-011US01

CERTIFICATE UNDER 37 CFR 1.8: I hereby certify that this correspondence is being transmitted by facsimile to the Commissioner for Patents at 703-872-9302

By: Angela Watson
Name: Angela Watson

MAIL STOP
Commissioner for Patents
Alexandria, VA 22313-1450

FAX RECEIVED

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AUG 29 2003

GROUP 3700

Sir:

We are transmitting herewith the attached correspondence relating to this application:

- ☒ Transmittal sheet containing Certificate of Mailing
- ☒ Restriction Requirement (3 pgs.)
- ☒ Request for Extension of Time for one months and fee of \$110.00 (1 pg.)

Please apply any charges not covered, or any credits, to Deposit Account No. 50-1778.

Date:

August 28, 2003

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By:

Kent J. Sieffert
Name: Kent J. Sieffert
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#3/Election

PATENT

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

In the Office Action mailed June 30, 2003, the period of response for which has been extended 1 month to August 30, 2003, the Examiner restricted claims 1-33 under 35 U.S.C. § 121 as follows:

- I. Claims 1-25 and 31-33, drawn to an apparatus, classified in class 29, subclass 740.
- II. Claims 26-30, drawn to a method, classified in class 29, subclass 832.

In support of the restriction, the Examiner cited MPEP 806.05(e) which states that a process and an apparatus for its practice can be shown to be distinct inventions if either or both of the following can be shown: (1) that the process as claimed can be practiced by another materially different apparatus or by hand, or (2) that the apparatus as claimed can be used to practice another and materially different process. The Examiner then stated "the process as claimed can be practice by hand."

Applicants hereby traverse this restriction, and submit that the process cannot be practiced by hand. In particular, independent claim 26 of Group II recites numerous limitations of the claimed apparatus thus preventing the recited method from being practiced by hand. More particularly, the elements recited by independent process claim 26 require the operation or manipulation of the apparatus claimed in the apparatus claims. As one example, claim 26 recites

"inserting a first tip of a first drive shaft attached to a first number into a first receptacle assembly attached to a second number so that a first helical groove on the first drive shaft aligns with a first pin located within the first receptacle assembly."

When MPEP 806.05(e) is read as a whole, it is clear that the meaning of section (1) is that one-way distinctness is shown between a process and an apparatus for its practice when the process as claimed can be practiced without the use of the claimed apparatus. The Examiner has misconstrued MPEP 806.05(e) to mean that the process is distinct from the apparatus if the process recites any step that may be practiced manually, even if that step requires manipulating the apparatus itself. This is clearly not the meaning of MPEP 806.05(e) as this would not show one-way distinctness between the apparatus and the process.¹

In addition, the Examiner asserted that Group I contains two patentably distinct species and referred to FIG. 1 and FIG. 4, and required Applicants to elect one of the species. However, the Examiner misconstrued FIG. 1 and FIG. 4 and the claims readable thereon. Specifically, FIG. 1 and FIG. 4 do not show different species. Rather, FIG. 1 and FIG. 4 and the claims readable thereon are directed to a combination and a sub-combination. As described in Applicants' specification, FIG. 1 illustrates "an example helical insertion and extraction device." FIG. 4 illustrates the "helical insertion and extraction device coupled with a printed circuit board prior to insertion into a system." Clearly FIG. 1 is directed to the device, i.e., the sub-combination, and FIG. 4 is directed to the device coupled to a printed circuit board, i.e., the combination.

In order to restrict claims directed to a combination and a sub-combination, the Examiner is required to show both two-way distinctness and reasons for insisting on the restriction, i.e., separate classification, status, or field of search.² Because the Examiner has incorrectly viewed FIG. 1 and FIG. 4 and the claims readable thereon as species, the Examiner has failed to meet these requirements. For example, the Examiner has failed to establish two-way distinctness, and the Applicants submit that the two-way distinctness does not exist. In this case, the claims readable on the combination clearly recite elements from the sub-combination. Moreover, in view of the claims and the recited elements of the sub-combination, it is clear that the Examiner

¹ "In applications claiming inventions in different statutory categories, only one-way distinctness is generally needed to support a restriction requirement." MPEP 806.05(e)

² MPEP 806.05(c).

will be required to perform co-extensive searches for the combination and the sub-combination. Accordingly, a restriction between the combination and sub-combination would be improper.

In a telephonic interview, the Examiner stated that his assertion that FIG. 1 and FIG. 4 represent different species relied, at least in part, on the premise that the printed circuit board was "oriented differently" with respect to the extraction device in each of the figures. Regrettably, the Examiner did not allow the Applicant an opportunity to respond and to point out the Examiner's misunderstanding of the figures. Apparently, the Examiner has confused the printed circuit board assembly 13 of FIG. 1 and the printed circuit board 60 of FIG. 4. In other words, based on the Examiner's remarks, it appears that the Examiner has mistakenly viewed the printed circuit board assembly 13 and the printed circuit board 60 as referring to the exact same component.

As described on pages 5-6, FIG. 1 illustrates an exploded view of helical device 10 fixed to printed circuit board assembly 13. As described in further detail on page 8, the helical extraction device 10 may attach to "plates or tabs 70A, 70B" that extend from the printed circuit board 60. In other words, the printed circuit board assembly 13 of FIG. 1 is merely illustrating the plates or tabs that are coupled to the actual printed circuit board being inserted or removed, as illustrated in detail in FIG. 4. Thus, it is clear that the orientation of device 10 relative to the printed circuit board is the same for FIG. 1 and FIG. 4, and that the embodiments illustrated in FIGS. 1 and 4 are in no way different species.

To the extent the Examiner maintains the restriction in view of the above-described errors, Applicants elect Group I with traverse. Within Group I, Applicants elect claims 1-11 with traverse.

Date:

August 28, 2003

By:

Kent J. Sieffert

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FACSIMILE TRANSMITTAL SHEET

TO:	Examiner - Rick Kiltae Chang	FROM:	Kent J. Sieffert
COMPANY:	USPTO	DATE:	AUGUST 28, 2003
FAX NUMBER:	703-872-9302	TOTAL NO. OF PAGES INCLUDING COVER:	6
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RE:	Response to Restriction Requirement	YOUR REFERENCE NUMBER:	09/940,261

☐ URGENT ☒ FOR REVIEW ☐ PLEASE COMMENT ☐ PLEASE REPLY

NOTES/COMMENTS: